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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/370,619 | 08/07/1999 | MICHAEL DAVID ERLANGER | 114459-05 | 8285 |

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WILLKIE FARR & GALLAGHER LLP
INTELLECTUAL PROPERTY LEGAL ASSISTANTS
787 SEVENTH AVE
NEW YORK, NY 10019-6099

EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3624

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/370,619

Applicant(s)

ERLANGER, MICHAEL DAVID

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 186-303 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 186-303 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 186-303 are pending. Claims 186, 194, 195, 198, 201, 213, 216, 222, 224, 228, 235, 237, 239, 241, 242, 243, 244, 253, 254, 259-261, 282, 287, and 294 and claims 299 –303 have been added in this communication filed 05/26/05 entered as Response to Election/Restriction.

Answer to Arguments With Traverse

2. Applicant's election with traverse of claims 187-251, Group II as proposed in April 2005 in the reply filed 05/26/05 is acknowledged. The traversal is on the ground(s) that the various groups remain misclassified. The misclassification will impair the quality of search. Group I (claim 186) is not classified in 705/35 ("computerized arrangement for planning the disposition or use of funds or securities, or extension of credit"). Applicant observes that it is highly unusual to divide a "picture" claim like claim 186 from all other claims. Applicant suggests that claim 186 should be grouped with claims 187-251. Group II (claims 252-263) are now classified in 705/38. However, Group II is generic to both credit and insurance and if 705/38 is a proper class for Group II, Group II should be searched in 705/35. Group III (claims 252-263) are now classified in 705/37. Group IV (claims 264-286) are now classified in 705/30 (accounting) and 705/30 is simply incorrect. The subject matter of these claims is not within the art of "accounting" as "accounting" is ordinarily understood by those in the art. Group V (claims 287-298) is now classified in 705/1. Over the several restriction requirement papers, the boundaries between groups have been inconsistent. Examiner Akers' earlier statement, that these

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claims are directed to a single invention, is simply disregarded, even though the MPEP indicates that it should be given "full faith and credit. All this strongly suggests that there is no principled basis for division of this application; rather, the restrictions appear to be mere "grasping at straws" to avoid examination.

There are two simple facts. (a) None of the claim groups falls entirely in any subclass; rather, each Group requires search in several subclasses, and the search subclasses for the Groups are essentially identical. The single best class for each group is the same. Under the MPEP's definition of "serious burden, there is no such burden, and no basis for restriction. (b) These claims are too interrelated to support a restriction requirement – a search for Group II will result in a search of the subject matter of the other groups. There is no "serious" search burden.

Response to Arguments from Restriction of 04/18/05: This is not found persuasive because the Examiner disagrees with Applicant regarding the classification of Group I, claim 186 as being ("computerized arrangement for planning the disposition or use of funds or securities, or extension of credit") because class 705, subclass according to my classification records is "Finance (e.g., banking, investment or credit)". The Examiner disagrees with Applicant's view of the subclasses for the restriction because not all of the Groups of claims will result in an search in subclasses 1, 35, 36, 37, and 38 with 35 being the single best classification. The inconsistent boundaries for the claims has been caused by making an attempt to appease the Applicant by at least meeting the Applicant half way and the 707 class for the claims was in error since I came from class 707 and have used class 707 for over seven years. Furthermore, the

Examiner is not "grasping for straws" to avoid the examination of the claims on the merits. It is respectfully requested, Applicant make an election to one Group of claims since the newly added claims have been assigned a group in order to move the prosecution forward. As for Examiner Akers, he is no longer with the Office and when an Examiner has been in the Office for a number of years the Examiner is more likely to give a restriction than an Examiner who has been with the Office for a short period of time. As explained in my last response to Applicant's traversal, (1) each independent group of claims has divergent subject matter requiring a different search on that subject matter. A restriction is not based only on the number of claims in an application. Claims can have divergent subject matter requiring a different search for each grouping of claims though they may be in the same class and subclass. However, Applicant's claims are in the same class but different subclasses because of their "divergent" subject matter. A restriction can be given at any time deemed proper during the prosecution process (1) when another Examiner is assigned the application it is treated as a new application and considers there to be a restriction though the previous Examiner did not give a restriction; (2) new claims have been added with divergent subject matter; and (3) there have been many independent and dependent claims added with differing subject matter creating a serious burden on the Examiner.

The restriction is still deemed proper and the Grouping of claims still remains as in the previous Restriction of 04/18/05 as set forth here below with claims 299 and 300 added to Group II, claims 187-251, claims 301 and 302 being added to Group III, claims 252-263, and Claim 303 being added to Group IV, claims 264-286.

Applicant **must** elect one group in view of the newly added claims to Groups II, III, and IV and **only** one group of claims to be examined **though the election be traversed** for the response to this Election/Restriction Requirement **to be considered responsive and compliant**.

Response to Arguments from Restriction of 12/10/04: Applicants' election with traverse of Group I, claims 186 and 287-297 and Group III, claims 241-251 in the reply filed on 1/26/05 is acknowledged. The traversal is on the ground(s) that (1) Applicants' respectfully submit that (a) the restriction requirement does not include claim 240 in any group and it should be examined with Group II. (b) Claim 186 has more in common with the independent claims of Group II than with Group I and should be examined with Group II. (c) Claim 241 (the independent claim of Group III) is obvious over claim 225 (in Group II). Therefore Group III should be examined with Group II. Response: The claims have been regrouped according to the independent claims and according to their claim limitations. MPEP 806.05 (c); (2) Applicant's submits that the search and examination of all pending claims of Groups I to IV can be made without serious burden, and therefore restriction is believed to be improper. MPE 803. This is not found persuasive because (1) each independent group of claims has divergent subject matter requiring a different search on that subject matter. A restriction is not based only on the number of claims in an application. Claims can have divergent subject matter requiring a different search for each grouping of claims though they may be in the same class and subclass. However, Applicant's claims are in the same class but different subclasses because of their "divergent" subject matter. A restriction can be given at

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any time deemed proper during the prosecution process. The restriction is still deemed proper.

Applicant **must** elect one group and **only** one group of claims to be examined **though the election be traversed** for the response to this Election/Restriction Requirement **to be considered responsive and compliant**.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 186, drawn to a method for in a market of loans or lines of credit offered to consumers, classified in class 705, subclass 35.
 - II. Claims 187-251, 299, and 300, drawn to a method and a computer programmed for in a market for a class of financial products and a predetermined pricing schedule for intermediation services providing credit for transaction fees, classified in class 705, subclass 38.
 - III. Claims 252-263, 301, and 302, drawn to a method on a secondary market for buying and selling loans to consumers and/or lines of credit to customers, classified in class 705, subclass 37.
 - IV. Claims 264-286 and 303, drawn to a method for an application process for financial products offered by offerors, classified in class 705, subclass 30.
 - V. Claims 287-298, drawn to a method and computer for obtaining information from an applicant for a financial product with information

relating to the qualifications of the applicant, classified in class 705, subclass 1.

Inventions Group II, Group III, Group IV, and Group V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination Group II as claimed does not require the particulars of the subcombination Group III as claimed because Group II has separate utility such as a market for a class of financial products and a predetermined pricing schedule for intermediation services providing for credit transactions.

Inventions Group IV and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group IV has separate utility such as an application process for financial products offered by offerors, obtaining information describing solicitations made by applicants or the financial products, closing the financial products, updating the database with information, making the database available. The subcombination group V has separate utility such as obtaining information from an applicant for a financial product, receiving

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and storing underwriting standards, automatically matching the applicant's information against underwriting standards of a plurality of offerors, and identifying to an applicant from among the offerors having underwriting standards that the applicant meets.

Group I, claim 186 links inventions Group II, claims 187-251 and 300 and Group III, claims 252-263, 301, and 302. The restriction requirement claims 187-251 and 300 and 252-263, 301, and 301 the linked inventions is **subject** to the nonallowance of the linking claim(s), claim 186. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant is advised that if any such claim(s) depending from or including all of the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-31 (CCPA 1971). See also MPEP 804.01.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, Group III, Group IV, and Group

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V, the search for Group II is not required for Group I, Group III, Group IV, and Group V, the search for Group III is not required for Group I, Group II, Group IV, and Group V, the search for Group I, Group II, and Group III, Group V is not required for Group IV, and the search for Group I, Group II, Group III, and Group IV is not required for Group V restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

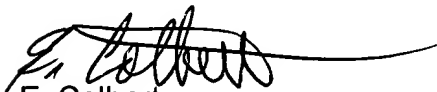
Inquiries

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
August 8, 2005